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In re Application of: :
MOVASSAGHI, Mehrzad : DECISION ON PETITION UNDER
U.S. Application No.: 10/530,014 : 37 CFR 1.47(b)
PCT No.: PCT/CA2003/001514 :
International Filing Date: 01 October 2003 :
Priority Date: 01 October 2002 :
Attorney's Docket No.: 1491-148 :
For: MULTIPLE-PLATE COMBUSTOR :
:

This decision is issued in response to the "Petition Under 37 CFR 1.47 Regarding Refusal Of An Inventor To Proceed" filed 16 December 2005, treated herein under 37 CFR 1.47(b). Applicant has submitted the required petition fee.

BACKGROUND

On 01 October 2003, applicant filed international application PCT/CA2003/001514. The international application claimed a priority date of 01 October 2002 and designated the United States. On 15 April 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 April 2005.

On 01 April 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 16 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 was required.

On 16 December 2005, petitioner filed a response to the Notification Of Missing Requirements that included the petition considered herein. The petition seeks acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1) and (3).

Regarding item (1), petitioner has authorized a charge to Deposit Account No. 03-1952 for the required petition fee (\$200). Based on this authorization, item (1) is satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP requires that the nonsigning inventor first be provided with a copy of the complete application papers, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a firsthand statement, with documentary support, demonstrating that the applicant has been provided with a copy of the assignment and declaration and has refused to execute these documents. However, petitioner has not provided a firsthand statement confirming that the inventor was provided with a copy of the complete application papers (including specification, claims, and drawings) prior to the refusal to execute the declaration, as required. Item (2) is therefore not satisfied.

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is satisfied.

Regarding item (4), the petition includes an unexecuted declaration that identifies the nonsigning inventor as the sole inventor, but the declaration has not been executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor. Item (4) is therefore not satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

The petition asserts that the declaration of Clifford W. Vermette, and the exhibits thereto, demonstrate that Powertech Industries, Inc. (Powertech) “was to own” the present application. However, these materials do not state that the inventor has assigned, or has agreed to assign, the present application to Powertech, nor is a copy of any such assignment or agreement to assign provided. Petitioner must therefore satisfy the requirements of category (C) above, that is, a showing that “the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.” Regarding such cases, section 409.03(f) of the MPEP states the following:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The present submission does not include such a legal memorandum. Accordingly, on the present record, item (5) is not satisfied on the present record.

Regarding item (6), petitioner has not made the express statement that granting of the present petition is necessary to preserve the rights of the parties or to prevent irreparable damages

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47(b)” and must include the materials required to satisfy items (2), (4), (5), and (6) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'R. Ross'.

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